Application No. 09/692,336

REMARKS/ARGUMENTS

This application is fully in condition for allowance, and has received a first action *(4 years after filing) Ex Parte Quayle* action with only an examiner requirement for internal "headings" [subtitles]. [There is no dispute that all the parts of this application are in the proper *order and sequence*.] This objection or attempted rejection solely for not having such internal headings is respectfully traversed as **not** *a USPTO mandatory requirement for patent applications*, as USPTO personnel have even acknowledged re electronic filing in response to my earlier email on this very same subject to the PTO, copied below.

From: Morgan, Paul F (OGC)
Sent: Friday, August 20, 2004 2:39 PM
To: Stephen.Kunin@uspto.gov
Cc: Charles.VanHorn@finnegan.com; 'charlene.woods@finnegan.com'
Subject: Forced use of Specification Subtitle "BRIEF SUMMARY OF THE INVENTION"

Steve, one of our more serious concerns about PTO's plans for mandatory electronic patent application filings is whether or not the PTO form or format will continue to force the use of the subtitle "BRIEF SUMMARY OF THE INVENTION. " We would also like to see that subtitle changed at its source, which is 37 CFR 1.77, such as to "BRIEF SUMMARY" or some other less dangerous subtitle, with a rule change specifically indicating in its accompanying PTO comments that 37 CFR 1.77 subtitles are NOT intended to imply that the claims are limited thereby.

This particular subtitle issue has become quite serious, because of unfortunate recent CAFC decisions" in which the Court *has expressly noted the presence of that subtitle* in the patent specification in suit *and used it to help narrow the claims with specification text appearing under that subtitle*. This new danger has been raised in patent law CLE programs, and is now becoming a patent application format issue with both in-house and outside counsel patent practitioners.

Although that subtitle BRIEF SUMMARY OF THE INVENTION [or any other subtitle other than for the Abstract] is NOT mandatory, we keep running into examiners rejections or objections insisting on its use, based on examiner misunderstandings that it is required or essential. This is a clear misinterpretation of PTO 37 CFR 1.77 "Arrangement of application." 37 CFR 1.77 is *not* one of the PTO Rules on *mandatory* parts of an application. 37 CFR 1.77(c) says that the respective text, if applicable "SHOULD" be preceded by a section heading in uppercase [and not underlined or bolded]. There should be no dispute as to the meaning of "should" in a PTO Rule. E.g., the August 1998 issue of the POPANEWS, the Patent Office Professional Association newsletter [reporting a PTO examiner arbitration decision] states that: "Noteworthy for examiners was [PTO] management's admission during the arbitration that the wording of a rule in the Manual of Patent Examining Procedure determines whether it is permissive or mandatory. PTO counsel and a management witness both agreed that

the MPEP's use of 'should' means the rule is permissive, while the use of 'shall' states the rule is mandatory."

These examiner rejections for not using subtitles are particularly frustrating if repeated in the final office action, because they are not appealable, and a petition against that rejection would take so long to be decided that the application would go abandoned in the meantime. [A classic "Catch 22"]

Furthermore, the use of subtitles within the specification is NOT allowed in many foreign patent applications, thus requiring amendments of U.S. specifications to remove them for foreign filing, contrary to PTO "harmonization" policies.

P.S. this subtitles issue should not be confused (as it is with some examiners) with providing the proper ORDER or SEQUENCE of the parts of a specification.

Thank you, Paul

c. Charles E. Van Horn, Chair, AIPLA PTO Relations-Patents Committee and Charlene Woods

*E.g., "[W]hen the preferred embodiment is *described in the specification as 'the **invention**' itself*, the claims are not necessarily entitled to a scope broader than that embodiment." *Modine Mfg. Co. v. United States Int'l Trade Commission*, 75 F.3d 1545, 1551(Fed. Cir. 1996) (emphasis added). In the May 13, 2003 decision of the Federal Circuit in *Storage Technology Corp. v Cisco Systems Inc.*, 66 USPQ 2d 1545 at 1553, the Court *expressly relied* on the fact that a particular term was used in a subtitled "Summary of the Invention" specification paragraph to render that term (which was only in the claim preamble) an express claim limitation. Other CAFC decisions such as SciMed Life Systems Inc. v. Advanced Cardiovascular Systems, Inc. (Fed. Cir. 11/14/01) and *Gaus v. Conair Corp.* 70 USPQ2d 1380 at 1384 (Fed. Cir. 2004) have also held the words "the invention" elsewhere in the specification against the patent owner."

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

CONTINGENT PETITION

If this objection or rejection is not withdrawn in favor of a Notice of Allowance, please treat this paper as Applicants' petition, and charge the applicable petition fee to Xerox Deposit Account No. 24-0025 [The Applicant's representative is effectively forced to do this because this matter is unlikely to be appealable, and the PTO refuses to consider petitions not timely filed from the date of the petitionable action in question.]

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A telephone interview is respectfully requested at the number listed below prior to any further Office Action, i.e., if the Examiner has any remaining questions or issues to address after this paper. The undersigned will be happy to discuss any further Examiner-proposed amendments as may be appropriate.

Respectfully submitted,

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PFM/gmm